

REMARKS

Applicant respectfully requests reconsideration of this application, as amended herein. Claims 1-4, 6-10, and 12-13 were pending in the application. In this amendment, Claims 1-4 and 7-10 have been amended for further clarification, and Claims 14-19 have been added. Therefore, Claims 1-4, 6-10, and 12-19 are pending in the application.

The Rejection under 35 U.S.C. § 102(b)

The Examiner rejected Claims 1, 6, 7, 12, and 13 under 35 U.S.C. 102(b) as being anticipated by Menge [US3578043]. Applicant respectfully traverses the rejection.

While Menge describes a cutting apparatus having a pivot arm with two pins that ride in separate slots, the slots cannot be joined into a single slot because the separate slots ensure that the motion of the cutting blade remains level, as illustrated in Menge figure 4. In contrast, the present invention requires that both bearing surfaces traverse in the same track so that the path of the saw blade can be both vertical and horizontal. In fact, Menge teaches away from the present invention. As described in the specification and claimed herein, the miter saw of the present invention enables a mechanism that allows the pivot point of the cutting arc to move in a predetermined path in the plane described by the rotating cutting surface. It is an element of the Menge invention that the motion of the pins in the slots obtains straight horizontal motion of the support beam (see column 5, lines 35-46). Menge further points out that it would be undesirable to have cutting movement that is not in a straight line. In contrast, the present invention teaches a cutting motion around a "floating pivot" having both a vertical portion and a horizontal portion. Accordingly, applicant respectfully asserts that independent Claims 1 and 7 of the present invention are patentably distinguished from Menge.

Claim 6 depends from Claim 1 and incorporates the same limitations as Claim 1, which, as described above, is patentably distinguished from Menge. Thus, Claim 6 is patentably distinguished. Claims 12 and 13 depend from Claim 7 and incorporate the same limitations as Claim 7, which, as described above, is patentably distinguished from Menge. Thus, Claims 12 and 13 are patentably distinguished.

The Examiner rejected Claims 1, 6, 7, 12, and 13 under 35 U.S.C. 102(b) as being anticipated by Schwandt [US2546277]. Applicant respectfully traverses the rejection.

As above Schwandt describes a cutting apparatus that enables a straight line cut. Schwandt has a pivot arm with a single pin that rides in a slot. A tie rod 59 adjacent and parallel

to the swinging arm maintains the cutting blade in a straight line through its motion (see column 4, lines 30-50). In contrast, the present invention requires two bearing surfaces that traverse in a common track so that the path of the saw blade can be both vertical and horizontal. In fact, Schwandt teaches away from the present invention. The present invention teaches a cutting motion around a "floating pivot" having both a vertical portion and a horizontal portion. Accordingly, applicant respectfully asserts that independent Claims 1 and 7 of the present invention are patentably distinguished from Schwandt.

Claim 6 depends from Claim 1 and incorporates the same limitations as Claim 1, which, as described above, is patentably distinguished from Schwandt. Thus, Claim 6 is patentably distinguished. Claims 12 and 13 depend from Claim 7 and incorporate the same limitations as Claim 7, which, as described above, is patentably distinguished from Schwandt. Thus, Claims 12 and 13 are patentably distinguished.

The Examiner rejected Claims 1, 6, 7, 12, and 13 under 35 U.S.C. 102(b) as being anticipated by Madsen [US1764965]. Applicant respectfully traverses the rejection.

Madsen describes a cutting apparatus having a pivot arm with two pins that ride in separate slots very similar to Menge above. As in Menge, the slots cannot be joined into a single slot because the separate slots ensure that the motion of the cutting blade remains level. In contrast, the present invention requires that both bearing surfaces traverse in the same track so that the path of the saw blade can be both vertical and horizontal. In fact, Madsen teaches away from the present invention. As described in the specification and claimed herein, the miter saw of the present invention enables a mechanism that allows the pivot point of the cutting arc to move in a predetermined path in the plane described by the rotating cutting surface. It is an element of the Madsen invention that the motion of the pins in the slots obtains straight horizontal motion of the support beam (see page 2, lines 126-127). In contrast, the present invention teaches a cutting motion around a "floating pivot" having both a vertical portion and a horizontal portion. Accordingly, applicant respectfully asserts that independent Claims 1 and 7 of the present invention are patentably distinguished from Madsen.

Claim 6 depends from Claim 1 and incorporates the same limitations as Claim 1, which, as described above, is patentably distinguished from Madsen. Thus, Claim 6 is patentably distinguished. Claims 12 and 13 depend from Claim 7 and incorporate the same limitations as Claim 7, which, as described above, is patentably distinguished from Madsen. Thus, Claims 12

and 13 are patentably distinguished.

The Rejection under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-4, 6-10, 12, and 13 under 35 U.S.C. 103(a) as being unpatentable over Madsen [US1764965]. Applicant respectfully traverses the rejection.

The Examiner points out the patent to Thomas et al. [US1662087] as showing a single arcuate track having a pair of roller bearings therein. The Examiner further takes Official Notice that it is well known to employ a track having both segments joined as one. Applicant respectfully points out that in the cited references and in Thomas et al., the configuration of the tracks/slots and pivot pins is designed to maintain the motion enabled by the pivot assembly in a straight line. Only the teaching of the present invention enables motion in both a vertical direction and a horizontal direction.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Examiner has impermissibly used the present teaching to assert that it would have been obvious to use a common track to obtain motion in two axes in the same plane. The Examiner may not use the patent application as a basis for the motivation to modify the prior art to arrive at the claimed invention. Furthermore, Applicant has amended Independent claims 1 and 7 to include elements that are not disclosed in Madsen. Accordingly, the present invention is patentably distinguished from Madsen.

Newly Added Claims 14-19

The newly added claim captures additional features of the invention that the Applicant claims as his own. The newly added claims depend from either of the independent claims, which as described above, are patentably distinguished from the references. Accordingly, Claims 14-19 are patentably distinguished. Applicant respectfully asserts that the newly added claims are in a condition for allowance.

CONCLUSION

Applicant has made a diligent effort to address the rejections identified by the Examiner and believes all claims remaining in the application are allowable. Accordingly, a Notice of Allowability is respectfully requested. However, if the Examiner is of the opinion that the present application is not in condition for allowance, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,

 5/1/06
Date _____

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